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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,461	06/23/2003	Robert Phillip Griffiths	9764-15US (12448)	7611

570 7590 12/13/2007  
AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER
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REDMAN, JERRY E

ART UNIT	PAPER NUMBER
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3634

MAIL DATE	DELIVERY MODE
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12/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/601,461	<b>Applicant(s)</b> GRIFFITHS ET AL.	
	<b>Examiner</b> Jerry Redman	<b>Art Unit</b> 3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 24-39 is/are pending in the application.
- 4a) Of the above claim(s) 31-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-30 and 33-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 24-30 and 33-39, drawn to a shutter assembly and a boss and cap assembly, classified in class 49, subclass 82.1.
- II. Claims 31-32, drawn to a method of assembling a shutter, classified in class 49, subclass 506.

The inventions are independent or distinct, each from the other because:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as inserting a single rack within a one of a pair of housings, attaching a toothed boss to the rack, attaching a shutter blade to an end cap, then attaching the shutter blade and end cap to the boss, and then attaching a second half of the housing to form a shutter assembly.

Newly submitted claims 31-32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 31-32 are directed to a method of assembling a shutter assembly.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-32 are withdrawn from consideration

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as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The status of the claims is as follows:

Claims 1-23 have been cancelled;

Claims 31-32 (newly added) are directed towards a non-elected invention (see above); and

Claims 24-30 and 33-39 are herein addressed below.

Claims 24-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 24, lines 11-12, the phraseology "at least one of said plurality of shutter blade end caps in respect of which a corresponding one of said plurality of bosses is integrally formed with the end cap" is not readily understood by the Examiner. In claim 27 lines 1 and 2, the phraseology "short" and "tight" are indefinite and fails to positively recite the invention. The phraseology "short" and "tight" fail to positively recite the claimed invention. In claim 29, line 3, the phraseology "either side of an engaging said boss being in the form of a toothed gear" is not readily understood by the Examiner. In claim 29, line 3, there is a lack of antecedent basis for "the form".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-30, 33-34 and 36-39 are rejected under 35 U.S.C. 102(b) as being anticipated by EP patent No. 119,369 to Balsamo. As shown in Figures 11-14, EP patent No. 119,369 to Balsamo discloses a shutter assembly having a plurality of overlapping shutter blades (2, substantially “fusiform”), an elongated translating member (13) adjacent to corresponding racks (claim 29, as best understood), an elongate housing (11) within which the translating member (13) translates, a plurality of bosses (12) connected to each shutter blade (2), a plurality of shutter blade end caps (3) supporting an end of the plurality of shutter blades (2), and each end cap (3) is formed with a sleeve cover (3a and 3a1, see figures 11 and 12).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 35 is further rejected under 35 U.S.C. 103(a) as being unpatentable over EP patent No. 119,369 to Balsamo in view of Givoni (6,499,255 B1). All of the elements

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of the instant invention are discussed in detail above except providing the pinion with teeth about 360 degrees. Givoni ('255) discloses a pinion gear having teeth (58) about 360 degrees. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the pinion gear of EP patent No. 119,369 to Balsamo with teeth about 360 degrees as taught by Givoni (6,499,255 B1) since teeth about 360 degrees provides greater stability between the translating member and the pinion gear.

Applicant's arguments with respect to claims 24-30 and 33-39 have been considered but are moot in view of the new ground(s) of rejection. It appears that the applicant is relying on how the shutter assembly is formed and not the apparatus per se. When assembled together, the elements are "integrally formed" together to form a shutter assembly.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Redman whose telephone number is 571-272-6835. The examiner can normally be reached on M-F from 8 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glessner, can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jerry Redman  
Primary Examiner

Jerry Redman  
Primary Examiner  
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